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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,112	02/12/2002	David Beran	DBI-003	6955
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David B. Ritchie THELEN REID & PRIEST LLP P.O. Box 640640 San Jose, CA 95164-0640				
			EXAMINER PARTHASARATHY, PRAMILA	
			ART UNIT 2136	PAPER NUMBER
DATE MAILED: 03/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/075,112

Applicant(s)

BERAN, DAVID

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is in response to the communication filed on 05/08/2002. Claims 1 – 52 were received for consideration. No preliminary amendments to the claims were filed. Claims 1 – 52 are currently pending.

### ***Claim Objections***

2. Applicant is advised that should claims 1 – 12 be found allowable, claims 13 - 24 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof and that should claim 51 be found allowable, claim 52 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3, 4, 11, 12, 15, 16, 23, 24, 29, 30, 31, 37, 38, 41, 42, 49 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The dependent Claims 3, 4, 15, 16, 29, 30, 42 and 43 read, "... popular titles ...", Claims 11, 23, 37, and 49 read, "... transmitting includes transmitting said audiovisual data at a rate faster than said playing speed", and Claims 12, 24, 38, and 50 read, "... transmitting includes transmitting said audiovisual data at a rate slower than said playing speed".

With respect to "popular titles", although the specification discloses "titles", the specification does not disclose "popular titles".

With respect to "a rate faster than said playing speed" and "a rate slower than said playing speed", although the specification discloses "the delivery company to deliver the movie faster or slower than the typical broadcast time depending upon efficiency and bandwidth", the specification does not disclose "a rate faster than said playing speed" and "a rate slower than said playing speed".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3, 8, 15, 20, 29, 41 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 15, 29 and 41 recite the limitation "popular titles". There is insufficient antecedent basis for this limitation in the claim.

Claims 8, 20 and 46 recite the limitation "said database". There is insufficient antecedent basis for this limitation in the claim.

The dependent claims 4, 16, 30 and 42 are rejected at least by virtue of their dependency on the dependent claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 – 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Morales (U.S. Patent Number 5,291,554).

6. Regarding Claims 1, 13, 51 and 52, Morales teaches receiving a request for audiovisual data from the user via a network, said audiovisual data corresponding to said request having a title (Column 6 lines 43 – 68);

determining if said title is already in a transmission schedule (Column 6 lines 43 – 68);

adding said title to said transmission schedule if it is not already in said transmission schedule (Column 6 lines 43 – 68);

encrypting said audiovisual data corresponding to said request using an encryption algorithm, said encryption algorithm having a corresponding decryption algorithm (Column 6 lines 18 – 34);

generating a decryption key unique to the user using said corresponding decryption algorithm (Column 6 lines 18 – 34);

forwarding said decryption key to the user via said network (Column 5 lines 60 – 68); and

transmitting said audiovisual data corresponding to said request to a satellite for receipt by the user with a satellite dish, said transmitting occurring in accordance with said transmission schedule (Column 6 line 58 – Column 7 line 36).

7. Regarding Claim 27, Morales teaches a database having one or more pieces of audiovisual data, each piece of audiovisual data having a title (Column 6 lines 43 – 68);

a transmitter coupled to said database (Column 5 lines 8 – 19);

an operator server coupled to a network and said database, said operator server

configured to receive a request for audiovisual data having a title from the user via said network, determine if said title is already in a transmission schedule, add said title to said transmission schedule if it is not already in said transmission schedule, encrypt said audiovisual data corresponding to said request using an encryption algorithm having a corresponding decryption algorithm, generate a decryption key unique to the user using said corresponding decryption algorithm, and forward said decryption key to the user via said network (Column 6 lines 18 – 34 and 43 – 68);

said database configured to forward said one or more pieces of audiovisual data to said transmitter according to said schedule (Column 5 lines 8 – 19); and

said transmitter designated to transmit audiovisual data to a satellite for receipt by the user with a satellite dish (Column 6 line 58 – Column 7 line 36).

8. Regarding Claim 39, Morales teaches means for receiving a request for audiovisual data from the user via a network, said audiovisual data corresponding to said request having a title (Column 6 lines 43 – 68);

means for determining if said title is already in a transmission schedule (Column 6 lines 43 – 68);

means for adding said title to said transmission schedule if it is not already in said transmission schedule (Column 6 lines 43 – 68);

means for encrypting said audiovisual data corresponding to said request using an encryption algorithm, said encryption algorithm having a corresponding decryption algorithm (Column 6 lines 18 – 34);

means for generating a decryption key unique to the user using said corresponding decryption algorithm (Column 6 lines 18 – 34);

means for forwarding said decryption key to the user via said network (Column 5 lines 60 – 68); and

means for transmitting said audiovisual data corresponding to said request to a satellite for receipt by the user with a satellite dish, said transmitting occurring in accordance with said transmission schedule (Column 6 line 58 – Column 7 line 36).

**9.** Claims 2, 14, 28 and 40 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches wherein said network is the Internet (Column 4 lines 37 – 47).

**10.** Claims 3, 15, 29 and 41 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches if said transmission schedule is empty, adding one or more popular titles to said transmission schedule (Column 7 lines 3 – 25).

**11.** Claims 5, 17, 31 and 43 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches wherein said encryption algorithm is based on the Pretty Good Privacy (PGP) (Column 6 lines 18 – 28).



**12.** Claims 6, 18, 32 and 44 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches wherein the user has a set-top box coupled to said network, and a satellite dish coupled to the set-top box, wherein the set-top box contains a storage device, and wherein the method further includes:

receiving the audiovisual data corresponding to said request using said satellite dish (Column 6 lines 18 – 28 and 43 – 68);

storing said audiovisual data corresponding to said request in said storage device (Column 6 lines 18 – 28 and 8 lines 12 – 18); and

decrypting said audiovisual data using said decryption key (Column 6 lines 18 – 28).

**13.** Claims 7, 19, 33 and 45 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches wherein the audiovisual data is a movie (Column 6 lines 43 – 68).

**14.** Claims 10, 22, 36 and 48 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches further including informing the user of a planned transmission time for said audiovisual data corresponding to said request (Column 5 lines 51 – 68).

**15.** Claims 11, 23, 37 and 49 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches wherein said audiovisual data corresponding to said request has a playing speed, and said transmitting includes transmitting said audiovisual data at a rate faster than said playing speed (Column 5 lines 51 – 68 and Column 7 lines 14 – 25).

**17.** Claims 12, 24, 38 and 50 are rejected applied as above in rejecting Claims 1, 13, 27 and 39. Furthermore, Morales teaches wherein said audiovisual data corresponding to said request has a playing speed, and said transmitting includes transmitting said audiovisual data at a rate slower than said playing speed (Column 5 lines 51 – 68 and Column 7 lines 14 – 25).

**18.** Claim 25 is rejected applied as above in rejecting Claim 13. Furthermore, Morales teaches wherein said audiovisual data corresponding to said request has a playing speed, and said transmitting includes transmitting said audiovisual data at a rate slower than said playing speed (Column 5 lines 51 – 68 and Column 7 lines 14 – 25).

**19.** Claim 26 is rejected applied as above in rejecting Claim 13. Furthermore, Morales teaches wherein said transmitting includes transmitting said audiovisual data via terrestrial digital transmission (Column 5 lines 51 – 59).

**20.** Claims 4, 16, 30 and 42 are rejected applied as above in rejecting Claims 3, 15, 29 and 41. Furthermore, Morales teaches wherein said one or more popular titles are determined by statistical analysis of past requests by users (Column 5 lines 51 – 68 and Column 7 lines 14 – 25).

**21.** Claims 8, 20, 34 and 46 are rejected applied as above in rejecting Claims 6, 18, 32 and 44. Furthermore, Morales teaches sending a query from the set-top box to the operator server through the network for a list of available titles;

compiling a list of available titles by scanning said database (Column 5 lines 51 – 68 and Column 7 lines 14 – 25); and

transmitting said list of available titles from the operator server to the set-top box (Column 5 lines 51 – 68 and Column 7 lines 14 – 25).

**22.** Claims 9, 21, 35 and 47 are rejected applied as above in rejecting Claims 6, 18, 32 and 44. Furthermore, Morales teaches wherein said storage device is a hard disk (Column 6 lines 38 – 42).

### ***Conclusion***

**24.** Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are

applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**25.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

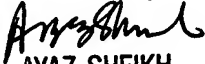
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

February 25, 2006.

  
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